

## **REMARKS**

### **Status of case**

Claims 1, 3-6, 8-11, and 13-14 are currently pending in this case.

### **Rejections under 35 U.S.C. §§ 102 and 103**

Claims 1-3, 5, 6, 8, 10 and 11 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,275,850 (Beyda et al.). Claims 4, 9, 13, and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Beyda.

The Office Action cites the Beyda reference as teaching the “generating” step recited in claim 1, stating the following:

“Col. 4, Ln 36–45, client devices are configured to automatically download attached files (request is made for download) only if the attributes of the email messages and their attachments satisfy a prescribed requirement.”

(Emphasis in original). For convenience, Applicants reproduce sections of the Beyda reference below:

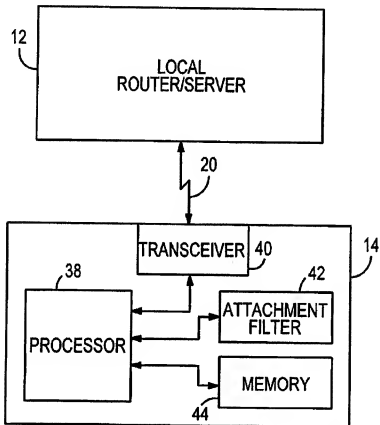
The client devices 14, 16 and 18 are enabled to identify attributes of email messages, including any attached files, that have been received and stored at the local router/server 12. Attributes may include a sender's identification, subject matter of the email message, format of the attached file, and size of the attached file. The sender's identification may be an email address that is utilized by the person sending the email message. However, the sender's identification may be a customized user name or user identification number.

In the preferred embodiment, the client devices 14, 16 and 18 are configured to automatically download attached files along with their associated email messages only if the attributes of the email messages and their attachments satisfy a prescribed requirement. The prescribed requirement may include one or more criteria that focus on the attributes of email messages and their attached files. The automatic downloading may occur when the receiving party establishes a communication connection with the local router/server 12 to access stored email messages. Alternatively, the automatic downloading may occur when the receiving party initiates down-loading of a particular email message from the local router/server 12. If an email message and its attached file do not satisfy the prescribed requirement, the client devices 14, 16 and 18 may be configured to download only the email message and not the attached file from the local router/server 12. (Col. 4, ln. 36-61)

Preferably, the attachment filter 42 of the client device 14 has been programmed by the receiving party prior to step 52 with a prescribed requirement for auto-downloading

attached files. The prescribed requirement may include the origin of the email message, i.e., the sender of the email message. For example, if the receiving party desires to automatically download only attached files from his/her boss, the receiving party can configure the attachment filter 42 accordingly. (Col. 6, ln. 30-38)

When the receiving party has accessed the local router/server 12, the processor 38 and the attachment filter 42 operate to determine whether to automatically download the attached file to the memory 44 from the local router/server 12. (Col. 6, ln. 63-67)



The Beyda reference states that element 14 is the “client device”. Further, the Beyda reference states that the “client device 14 is shown to contain . . . an attachment filter 42”. Col. 5, lines 2-5.

Applicants respectfully contend that the invention as currently claimed does not simply recite that the determination whether to download an attachment is made only by the communication terminal. For example, the communication terminal of the present invention does not simply: (1) include a filter to examine attributes stored on the communication terminal’s memory to make a determination to download the attachment; and (2) send a command to the server to automatically download (or not to download) the attachment.

Instead, the communication terminal and the server device work in combination to make

that determination. Specifically, the “generating” step in claim 1 recites that the communication terminal generates a “request” that includes “data indicating the type information stored in the memory” of the communication terminal. See also claim 6. The communication terminal then sends the request to the server (see the “sending” step recited in claim 1). See also claims 6 and 11. The server, using the “type information” in the request, makes a determination – namely, “determining . . . whether a type of attachment file of e-mail . . . is identical to a type identified by the type information” in the request. See claims 1 and 11. Based on the server’s determination (the “determining” step), the server either: (1) sends the e-mail with the attachment deleted “when the type of the attachment file of the e-mail is not identical to the type identified by the type information”; or (2) sends the e-mail “when the type of the attachment file of the e-mail is identical to the type identified by the type information”. See claims 1 and 11.

Thus, the invention as presently claimed does not have either the communication terminal or the server solely make the decision. Quite the contrary, the communication terminal and the server work must in combination, with the communication terminal sending the type information that identifies a type of an attachment file that a user of the communications terminal desires to receive. The server then uses this type information to make the determination whether to send the attachment. In this way, there is no filter on the communication terminal that makes the sole determination and then issues an automatic download command.

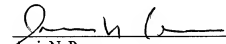
Having the communication terminal and server work in combination to make the decision whether to download the attachment is very beneficial. For example, a user of the communication terminal is able to rewrite or update the type information (and send the type information in the request). And, since the communication terminal automatically generates the request and sends the request to the server upon receipt of an arrival notice from said server apparatus, the communication terminal may simply receive the e-mail from the server without requiring the server additional (and costly) processing. Specifically, since the communication terminal sends the type information in the request to the server, the server may forgo searching and filtering e-mails for the communication terminal. As a result, the time required for the communication terminal to access the server is reduced, thereby reducing the uplink traffic of the communication network. This is particularly advantageous, given that a communication network is typically configured such that the bandwidth of the downlink communication is greater than that of the uplink communication. Applicants thus believe that the division of responsibilities

between the communication terminal and the server is particularly suited to the downloading context as claimed. Therefore, Applicants respectfully contend that the claims as currently presented are patentable.

**SUMMARY**

Applicant respectfully requests early allowance of this application. The Examiner is invited to contact the undersigned attorneys for the Applicant via telephone if such communication would expedite this application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Amir N. Penn', is written over a horizontal line.

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